

REMARKS

Claims 1-35, all the claims pending in the application, stand rejected. Applicants respectfully submit that the claims are patentable for the following reasons.

Claim Rejections - 35 U.S.C. § 103

Claims 1-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over “Yamada Sone”(5,919,047) in view of Tsai et al (6,352,432). This rejection is traversed for at least the following reasons.

As a preliminary matter, Applicants note that the Examiner cites the primary reference as “Yamada Sone”, but appears to describe only the teachings of the patent to Sone (5,919,047). Applicants assume that the word “Yamada” is a typographical error and does not refer to a third reference that the Examiner relies upon for the rejection. Clarification is requested as the Examiner did cite, but did not apply, a new reference to Yamada in this Office Action.

The Examiner acknowledges that the present Office Action is based upon the Amendment filed on September 22, 2003, in which claims 1, 7-8, 10, 13-22 and 25-32 were amended. Nonetheless, in framing the rejection, the Examiner has repeated verbatim the text of the rejection made of claims 1-35 in the Office Action dated June 20, 2003. Thus, Applicants would submit that claims 1-35 are patentable for all of the reasons given with respect to the amended claims in the Amendment filed on September 22, 2003.

In the present Office Action, beginning at page 6, the Examiner responds briefly to the arguments and amendments made by the Applicants, which highlight the distinguishing features of the present invention. The Applicants made three primary arguments in distinguishing over Sone. The Examiner has rejected each of these arguments, relying heavily upon the illustration of Fig. 7(B) in the reference and the accompanying description. The Examiner has interpreted the teachings with regard to Fig. 7(B) in a manner that is unsupported by, and inconsistent with, the disclosure in Sone. The Examiner also has combined embodiments of Sone without any teaching or suggestion, relying only on their presence in a single reference and ignoring clear incompatibilities and differences in purpose.

The Examiner's Combination of Figs. 7(B) and 7(C) is Unsupported

The Examiner takes the position that one skilled in the art would combine the “indirect joint” of Fig. 7(B) with the bridge section embodiment of Fig. 7(C). However, in doing so, the Examiner fails to recognize that the illustrated embodiments of Figs. 7(A), 7(B) and 7(C) are alternative embodiments. These represent clearly distinct and different modes. Sone refers to these separately as three separate transition modes: (1) joining, (2) cross-fading and (3) bridging. There is no teaching or suggestion that these modes, particularly the cross fading mode in Fig. 7(B) and the bridging mode of Fig. 7(C) may be combined. As subsequently demonstrated, these two modes have purposes, and are supported by illustrations and explanations, that are inconsistent with their combination as proposed by the Examiner.

Indeed, the Examiner's own combination demonstrates the improper use of hindsight based upon the Applicants' own teaching in attempting to define an invention that is uniquely conceived by the Applicants. Even if the Examiner may have established a *prima facie* case for at least stating the rejection, in the Amendment filed on September 22, 2003, and as demonstrated herein, Applicants have clearly and successfully rebutted the *prima facie* case.

In particular, the Applicants had overcome any *prima facie* case that the Examiner may have established by the following rebuttal:

The bridge section of Sone is not determined prior to selection

Applicants argued that Sone in view of Tsai does not disclose that the bridge section is generated before the selections are made and stored for later selection and use. The Examiner responds that Sone provides a cross-fading mode (Fig. 7(B)) that incorporates “two or more songs,” where the first song is the first music output means, the second song is the connection music output means and the third song is the second music output means.

Applicants respectfully submit that the embodiment of Fig. 7(B) concerns only two songs. The text at col. 9 defines a “cross-fading manner” of transition, which makes sense only with respect to two songs where the music properties of a preceding and succeeding music piece are not compatible with each other. The Examiner's addition of a third song and a revision of the disclosed embodiment to include more than two songs is improper and has no supported teaching or suggestion in any prior art reference. Even if there is a medley of three or more

songs, each transition mode would involve only two songs, and would not have the claimed features of the invention. In short, no cross-fading mode performance would have any predetermined connection music established prior to selection of original music for playback, as claimed.

Sone is limited to Saba and has no preamble or post amble

The Examiner asserts that Fig. 7(B) illustrates a time when a first music piece section starts to fade out until the piece fades entirely and considers this a post amble section. Similarly, the Examiner considers the time when the second music starts to fade in until a second music piece section is exclusively played as a preamble. The Examiner then hypothesizes that there is “no exclusion” in Sone of the use of pieces of music as connection music and a third piece of music acting as a second music output.

Clearly, “no exclusion” is not the standard for obviousness. The art must teach or suggest a combination that is considered to be obvious. The standard is not that the art excludes the use of combination, although a statement of exclusion certainly does demonstrate the lack of obviousness. In the absence of any affirmative teaching or suggestion of a use of a preamble or post amble in the original music in connection with the generation of a sequence of original pieces using a connection piece, the claims would be patentable.

While the Examiner asserts that the end of the first music piece and the beginning of the second music piece that are subject to fading in Fig. 7(B) are preamble and post amble pieces, there simply is no combination of a preamble, post amble and connection music, as claimed. The Examiner cannot show in the illustration of Fig. 7(B) the presence of all three elements, which are set forth in the claims.

Sone has no connection music output concurrent with a preamble or post amble

Applicants have argued that Sone relies upon abrupt transitions from the first music piece section to a bridge section, as illustrated in Fig. 7(C). The notation used by Sone is clear: a straight line (Fig. 7(c)) defines a abrupt transition from one music piece to a bridge section and a bridge section to a second music piece, and a curved line (Fig. 7(B)) defines a cross fade. There is no teaching or suggestion that any fading should be used in the transition illustrated in Fig. 7(c). The Examiner is engaged in improper hindsight by combining the technique of Fig. 7(B),

Response Under 37 C.F.R. § 1.116
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which is expressly directed to the transition from incompatible pieces (col. 9, lines 50-52) and a case where a bridge section is inserted abruptly between first and second music pieces.

The purposes for the indirect joint in Fig. 7(B) and 7(C) are incompatible and, in any event, their disclosure does not support combining them together. Even if one may now conclude that such combination is possible from the illustrations in Sone, the Applicant was the first to recognize such possibility and to implement them, thereby solving a problem that existed in the art. The teachings in Sone of each of these separate modes do not suggest their combination. The proper standard for patentability under U.S. law must be observed by the Examiner in framing his rejection. Applicants submit that the Examiner has not done so..

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

Ronald Kasper RA 44,186
Alan J. Kasper
Registration No. 25,426

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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